



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22312-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,634	10/15/2001	Kiyofusa Egashira	JP920000319US1	3272

7590 12/30/2004

Ronald A. D' Alessandro, Esq.
Hoffman, Warnick & D' Alesandro LLC
Three E-Comm Square
Albany,, NY 12207

EXAMINER

POND, ROBERT M

ART UNIT	PAPER NUMBER
----------	--------------

3625

DATE MAILED: 12/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/977,634

Applicant(s)

EGASHIRA ET AL.

Examiner

Robert M. Pond

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

The Applicant amended independent Claims 1 and 6 and based arguments on the amended claimed subject matter. All pending claims (1-10) were examined in this final Office Action necessitated by amendment.

Response to Arguments

Rejection under 35 USC 101

Applicant's arguments, see Remarks, filed 29 September 2004, with respect to Claims 1-5 have been fully considered and are persuasive. The rejection under 35 USC 101 of Claims 1-5 has been withdrawn. The Examiner interprets Claims 1-5 as providing a practical application in the technological arts in light of the specification and claim preamble.

Rejection under 35 USC 102

Applicant's arguments, see Remarks, filed 29 September 2004, with respect to Claims 1, 2, 6, and 7 have been fully considered and are persuasive. The rejection under 35 USC 102 of Claims 1, 2, 6, and 7 has been withdrawn as necessitated by amendment. Please see below.

Rejection under 35 USC 103- Claims 1, 2, 6, and 7

Applicant's arguments filed 29 September 2004 have been fully considered but they are not persuasive. Chou teaches determining matching bid/asks based

on price and required volume of goods (please note: volume determined by quantity of each good times its volume and computing a total volume) (see at least col. 3, lines 8-16), and arranges ask ordering in ascending order based on price. Chou then determines feasibility that provides a qualification as to whether the service exists (e.g. trade route, departure time, arrival time) (see at least col. 3, lines 3-45). The Examiner respectfully disagrees with the Applicant's statement regarding feasibility matching of Chou. One of ordinary skill in the art would ascertain that feasibility matching merely further reduces a matching set based only on price and quantity that minimizes the effort necessary to wade through all the items matched only on desired price and desired quantity.

Rejection under 35 USC 103- Claims 3-5 and 8-10

Applicant's arguments filed 29 September 2004 have been fully considered but they are not persuasive. The Applicant relies upon arguments applied to amended independent Claims 1 and 6. As noted above, the Examiner respectfully disagrees with the Applicant for the reasons noted above applicable to amended independent Claims 1 and 6.

Official Notice (regarding well within the skill)- Claims 3-5 and 8-10

The Applicant did not traverse the examiner's assertion of well within the skill. The common knowledge or well-known in the art statement is taken to be admitted prior art because applicant failed to traverse or adequately traverse the examiner's assertion of official notice (MPEP 2144.03(C)).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. **Claims 1, 2, 6, and 7 are rejected under 35 USC 103(a) as being unpatentable over Chou et al. (Paper #2, patent number 6,035,289 hereinafter referred to as "Chou"), in view of Official Notice (regarding well within the skill hereinafter referred to as "ON1")**

Chou discloses a method of trade-building by matching a plurality of posted wish (hereinafter referred to as bid) records and a plurality of posted ask records to support buyer-seller trading over the Internet (please see at least abstract; Fig. 1 (10, 12, 14, 16, 17, 18, 20); col. 1, lines 5 through col. 2, line 25). Chou further teaches:

- Obtaining supply information from at least one supplier and storing:
obtains and stores electronic asking price records from one or more carriers (hereinafter referred to a "suppliers") (see at least col. 2, line 59 through col. 3, line 8); supplier provides capacity information (e.g. quantity of truckloads have a predetermined span (e.g. departure time and arrival time) (see at least col. 5, lines 63-64; col. 6, lines 3-4); means for obtaining supplier information via Internet network, clearing house

computer, and electronic storage (see at least Fig. 1 (17, 18); col. 6, lines 43-47).

- Receiving purchase wish information and storing: receives and stores electronic bid price records from shippers (hereinafter referred to as "buyers") (see at least col. 2, line 59 through col. 3, line 8); means for receiving buyer information via Internet network, clearing house computer, and electronic storage (see at least Fig. 1 (17, 18); col. 6, lines 43-47).
- Predetermined time period: matches at periodic intervals (see at least col. 6, lines 44-45); time spans established by buyers and sellers (e.g. departure times, arrival times) (see at least col. 5, lines 59-62; col. 6, lines 3-4).
- Selecting optimum combination; comparing the desired purchase price and desired purchase quantity: matching to optimize trades (see at least col. 2, lines 26-34); lower average cost and achieve higher average profits (please note examiner's interpretation: achieving higher average profits while attempting to achieve lower average costs controls aggregate profit) (see at least col. 2, lines 45-50); determining matching bid/asks based on price and required volume of goods (please note examiner's interpretation: volume determined by quantity of each good times its volume and computing a total volume) (see at least col. 3, lines 8-16); arranges ask ordering in ascending order based on price, then determines feasibility matching that provides a qualification as to whether the service exists (e.g.

Art Unit: 3625

trade route, departure time, arrival time) (see at least col. 3, lines 33-45);

trading goods (examiner's example of tangible good: 100 board feet of #1 grade pine 1x8) (see at least col. 1, lines 59-63).

- Transmitting notification: posts all of the executable trades (see at least col. 4, lines 24-25).

Chou teaches all the above as noted under the 103(a) rejection and teaches a) matching on desired price and desired quantity, and b) matching feasibility to ascertain whether the service exists, but does not disclose matching only on desired purchase price and the desired purchase quantity. It would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of Chou to match only on desired purchase price and the desired purchase quantity, since it is well within the skill to ascertain that feasibility matching merely reduces a matching set based only on price and quantity.

Pertaining to system Claims 6 and 7

Rejection of Claims 6 and 7 is based on similar rationale as noted above.

2. **Claims 3-5 and 8-10 rejected under 35 USC 103(a) as being unpatentable over Chou (patent number 6,035,289) and ON1 (regarding well within the skill), as applied to Claims 2 and 6, further in view of ON2 (Paper #2, regarding well within the skill)**

Chou and ON1 teach all the above as noted under the 103(a) rejection and further teach arranging ask records in ascending order and matching bids to asks, but do not disclose arranging in descending order. It would have been obvious to one of ordinary skill in the art at time of the invention to arrange records in descending order, since it is well within the skill to ascertain that arranging in either ascending or descending order removes randomness from the information, thereby facilitating the matching process.

Pertaining to system Claims 8-10

Rejection of Claims 8-10 is based on similar rationale as noted above.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mr. Robert M. Pond** whose telephone number is 703-605-4253. The examiner can normally be reached Monday-Friday, 8:30AM-5:30PM Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Ms. Wynn Coggins** can be reached on 703-308-1344.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **703-308-1113**.

Any response to this action should be mailed to:

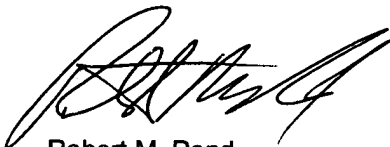
Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to:

703-872-9306 (Official communications; including After Final
communications labeled "Box AF")

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.



Robert M. Pond
Primary Patent Examiner
December 23, 2004